

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Adam-Worrall et al.

Application No.: 10/583,013

Conf. No.: 6111

Filed: June 15, 2006

Art Unit: 1624

For: TRICYCLIC 1-[(INDOL-3-
YL)CARBONYL)PIPERAZINE
DERIVATIVES AS CANNABINOID CB1
RECEPTOR AGONISTS

Examiner: Emily Bernhardt

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
DETERMINATION UNDER 37 CFR §1.705(B)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Allowability issued December 2, 2009, Applicants respectfully request reconsideration of the Patent Term Adjustment of 0 days noted on page 3 of the Notice, and request that it be corrected to 72 days. The present request, being filed along with the issue fee transmittal, is timely. 37 C.F.R. §1.705(b).

The office is authorized to charge deposit account no. 50-4205 the required fees set forth in 37 C.F.R. §1.18(e) (\$200) and 37 C.F.R. §1.705(b)(1).

Applicants respectfully submit that the correct Patent Term Adjustment is 72 days. The basis upon which Applicants request reconsideration of the patent term adjustment is as follows (for details see attached AIPA Term Calculation Report utilizing Professor Kayton's patent Term® on line program):

1. Under the 14-Month Rule [(§1.703(a)] the present application was filed on January 15, 2006 and the First Action was mailed January 8, 2008. Accordingly under the 14-Month Rule the period of adjustment for the USPTO delay is 146 day which is also reflected in the Patent Term Adjustment History.

2. Under the 3-Month Rule [(§1.704(b)], a period of adjustment of 57 days of Applicant delay has been calculated from the Non-final Action mailed January 8, 2008 to the date of Reply to this Action, June 4, 2008, as is also reflected in the Patent Term Adjustment History.

3. Under the 3-Month Rule [(§1.704(b)], a period of adjustment of 81 days of Applicant delay has been calculated from the Non-final Action mailed September 8, 2008 to the date of Reply to this Action, February 27, 2009, as is also reflected in the Patent Term Adjustment History.

4. Under the 3-Month Rule [(§1.704(b)], a period of adjustment of 91 days of Applicant delay has been calculated from the Final Action mailed May 19, 2009 to the date of Reply to this Action, November 18, 2009, as is also reflected in the Patent Term Adjustment History.

5. However, should a patent issue after June 15, 2009 (three years from the June 15, 2006 filing date of the application), adjustment of the patent term pursuant to 35 U.S.C. §154 (b)(1)(B) [(§1.703(b), stipulating issuance of a patent within three years of the application filing date] would be implicated based upon the Wyeth et al. v. Dudas ruling recently published (No. 2009-1120, Federal Circuit, January 7, 2010). Assuming an estimated issue date of June 15, 2010, it is respectfully submitted that the period of adjustment for USPTO delay (in accordance with the ruling in Wyeth et al. v. Dudas) begin on the day after the three year period, June 15, 2009 (see attached AIPA Term Calculation Report utilizing Professor Kayton's patent Term® on line program) and end on the aforementioned estimated issue date, which is a period of adjustment due to USPTO delay of 155 days.

5. Accordingly, Applicants respectfully submit that the patent term adjustment period is the total days debited the USPTO, 301 days, minus the total number of days debited Applicants, 229

days, to yield a total patent term adjustment of 72 days ((see attached AIPA Term Calculation Report utilizing Professor Kayton's Patent Term on line program).


Applicants reserve the right, under 37 C.F.R. §1.705(d), to request further revisions to the patent term adjustment, should the Office fail to note the revised patent term adjustment on the face of any patent issuing from the present application, or fail to timely issue any patent issuing from the present application.

Early and favorable action is earnestly solicited.

Dated: March 1, 2010

Respectfully submitted,

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Attachment

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